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In re Application of
Brennan et al.
Serial No.: 10/602,998
Filed: June 23, 2003
Attorney Docket No.: 28690-705.302

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.181, filed July 12, 2006, requesting that the after final amendment filed on April 24, 2006 be entered into the above referenced application. The delay in acting upon this petition is regretted.

BACKGROUND

A review of the file history shows that the examiner mailed a non-final Office action to applicants on April 18, 2005, setting forth a three-month shortened statutory period for reply in which claim 14 was objected to as being an improper dependent claim. Claims 1, 14, and 15 were rejected under 35 USC 102(e) as being anticipated by Boles et al. The examiner also rejected claims 2-13 under 35 USC 103 as obvious over Rava et al. and Boles et al.

Applicants replied on August 12, 2005 and cancelled claim 14 and amended claims 1 and 2. Applicants also traversed both rejections made under 35 USC 102 (e) and 35 USC 103 wherein applicants indicated that the 102 (e) was overcome because of the submitted declarations and the 103 rejection was overcome because the references do not teach the claimed limitations.

In response to applicants' remarks, the examiner mailed a second non-final Office action on September 7, 2005 setting forth a three-month shortened statutory period for reply in which claims 1 and 15 were rejected under 35 USC 102 (b) as being anticipated by Monforte et al. Claims 2-13 were also rejected under 35 USC 103 as being unpatentable over Rava et al. and Monforte et al. taken together.

Applicants replied to this Office action on February 7, 2006 and amended the claims to recite that the primer is adapted to be released before, during or after the amplification reaction.

Applicants also argued that the primers of Monforte et al. can only be cleaved after amplification and, thus, Monforte et al. can neither be used in a 35 USC 102 or 35 USC 103 rejection.

The examiner mailed a final Office action to applicants on February 23, 2006, setting a three month shortened statutory period for reply. The examiner repeated the 35 U.S.C. 102 (b) rejection from the previous Office action. The examiner also repeated the 35 U.S.C. 103 rejection from the previous Office action.

On April 24, 2006, applicants requested reconsideration of the finality of the Office action of February 23, 2006 and amended the claims by deleting the claim language "during or after" in reference to the amplification reaction.

On May 5, 2006, the examiner mailed an advisory action which stated that the amendment after final would not be entered as the proposed amendment raised new issues and did not simplify the issues for appeal.

In response thereto, applicants filed a petition on May 25, 2006 requesting that the amendment filed on April 24, 2006 be entered into the above referenced application.

On June 20, 2006, a petition decision was mailed to applicants stating that the petition was denied.

In response thereto, applicants filed this renewed petition on July 12, 2006 asking for reconsideration of the decision of June 20, 2006.

DISCUSSION

Applicants' petitioned the denial of entry of the after final amendment asserting that first the examiner in effect suggested the amendment in the interview, second that a complete search of the previous claim to before, during or after would have included references drawn to each embodiment and third the amendment does reduce the issues for appeal.

The petition for entry was denied because remarks made by the examiner in the Interview Summary were not an invitation to amend the claims guaranteeing entry thereof. Applicants' claims alternatively set forth the requirement that the sequences be adapted to be released before, during or after. Thus, there was no requirement that the examiner find each adaptation during his search. Finally, the issues for appeal were not reduced as a new search and consideration would have been necessary as the proposed amendment deletes "during or after" which significantly changes the scope of the claim, as evidenced by the fact that allowing entry of the amendment would have removed Monforte et al. as a reference.

Applicants' continue to argue that the examiner was obligated to search for each of the embodiments recited in the claim and that presented with three alternatives, the examiner is obligated to provide a complete search and examination of the whole scope of the claim.

Applicants' continue by stating that although it is possible for the examiner to use prior art to only one embodiment to reject the claim, it is not acceptable to only search one of the embodiments. This argument is not persuasive for the same reasons set forth in the last petition decision. Specifically, the examiner is under no obligation to search for each and every embodiment set forth **alternatively** in the claims.

DECISION

The petition is again **DENIED**. Any new or renewed petition must be filed within TWO MONTHS of the mail date of this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.



George Elliott
Director, Technology Center 1600